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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,585	10/26/2001	William A. Montague	0236/US	8115
30333	7590	03/25/2005	EXAMINER	
FRANCIS J. CAUFIELD 6 APOLLO CIRCLE LEXINGTON, MA 02421-7025			D AGOSTA, STEPHEN M	
			ART UNIT	PAPER NUMBER
			2683	

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/005,585	MONTAGUE, WILLIAM A.	
	Examiner	Art Unit	
	Stephen M. D'Agosta	2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 4-8 is/are allowed.
6) ☒ Claim(s) 1-3, 9-16, 18, 20, 21, 23 and 25-27 is/are rejected.
7) ☒ Claim(s) 17, 19, 22, 24 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 12-3-04 have been fully considered but they are not persuasive.

1. The applicant argues (page 11-12) that the 102b rejection does not teach "bearing a tactile indicator". The examiner disagrees – Tobish's main focus is to provide a locator aid to identify number keys (eg. 911). The claim is written in such a way as to be open to broad interpretation and it appears that the applicant is narrowly interpreting the claim to overcome the examiner's art. Case in point – the "term" bearing can mean "to bear the weight of" when it is written as "load-bearing" (which would be strange for this device since a key on a phone is not typically thought of as bearing any weight (hence the examiner interpreted the claim as the key "having/showing/possessing" a tactile indicator to allow a user to locate certain keys – which is what Tobish teaches). The applicant's claim would have overcome the examiner's prior art had it been written as "a key comprising an indicator on said key". As pointed out above, the term bearing is open to interpretation and is not empirical. For example, an insignia bearing the word "XYZ" is more often interpreted as the insignia "having/showing" the word "XYZ" on it rather than the insignia "bearing the weight" of the word "XYZ". Lastly, the examiner notes that the applicant has not pointed to the specification to back up their reasoning, hence the claim is open to interpretation. The applicant is invited to amend their limitation(s) to more accurately recite that which is being claimed and overcome the prior art (thus avoiding broad interpretations). Also see #3 below for further clarification.

2. The applicant argues, (page 12) that the 102b rejection does not teach "not substantially obscuring the visual indicators on the keys". The examiner disagrees since Tobish teaches strips made of plastic (C4, L24-32 - which can be clear) and with holes cut out (see figure 4) so as not to substantially obscure the visual indicator (also see figure 8 which allows one to see the "1" and "9" with the tactile indicators on the phone). The applicant's argument that the examiner's assertion about the properties of plastic (eg. being clear) is not persuasive. Plastic is a well known material that can be manufactured as clear, opaque, etc. and one skilled would interchangeably use clear/opaque plastic in Tobish's invention – Tobish teaches that the tactile indicator can have many embodiments (C2, L66 to C3, L7) which affirms the examiner.

3. The applicant argues that claims 15 and 20 are not rejected properly based on "attached to the number key" not being taught. While Tobish teaches adding tactile indicators to the phone, the means in which he arrives at the solution is varied from that of the applicant's invention. Tobish attaches/glues a tactile indicator to the phone casing rather than directly to the key(s). Tobish also allows for different embodiments within the spirit and scope of his invention. Hence one skilled would inherently attach a smaller version of the tactile indicator to the key itself (eg. glue a clear plastic indicator to the key) without departing from the true functionality of the invention, eg. providing

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locating aids to find the "9" and "1" keys. The examiner is not swayed since there is no novel difference between where the indicator is glued, as long as it is attached to the phone itself.

4. The applicant argues the 103 rejection for claims 16-17 and 21-22 regarding how Bianchini is applied. The examiner is not swayed – firstly #1-#3 above addressed the examiner's position regarding "attaching tactile means to the key". Secondly, Bianchini is correctly applied to teach adding a "cover" to the key to provide means for tactile identification. Hence Tobish+Bianchini reads on the claim.

5. New claims 25-27 are rejected in a similar fashion as was claim 15.

6. After further review, the examiner now objects to claims 17, 19, 22 and 24 based on their highly specific design features.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9, 13, 15 and 20 and 25-27 rejected under 35 U.S.C. 102(b) as being anticipated by Tobish US 5,444,775 (hereafter Tobish).

As per **claim 1**, Tobish teaches a phone having a keypad comprising at least ten number keys arranged to dial the digits from 0-to-9 inclusive (figures 1 and 5 show phones with numbers 0-9), each of said number keys being marked with a visual indicator denoting the digit which the number key is arranged to dial (figures 1 and 5 show visual indicators representing numbers 0-9 for each key), the number key arranged to dial the digit "1" bearing a tactile indicator (figures 1 and 5 show the "1" key with tactile indicator #18/#42), and the number key arranged to dial the digit "9" bearing a second tactile indicator (figures 1 and 5 show "9" key with tactile indicator #18 again or #44), said first and second indicators not substantially obscuring said visual indicators on said keys bearing said tactile indicators ("locator aids" shown in figures 1 and 5 do not obscure the key, but rather mark the key's location), said tactile indicators not being the Braille equivalents of the digits which said numbers bearing said tactile indicators are arranged to dial ("locator aids" are not Braille equivalents). The examiner also refers to figure 8, abstract and C2, L30 to C3, L47 and C4, L24-32 teaches non-obscuring).

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As per **claim 9**, Tobish teaches claim 1 wherein at least one of said tactile indicators is substantially transparent (C3, L8 teaches the indicator is made of plastic which can be see-through, opaque, etc. and reads on "substantially transparent").

As per **claim 13**, Tobish teaches claim 1 wherein all of said keypad is molded of a single elastomeric (eg. non-conducting per specification, page 8 L21-32) material (Tobish teaches plastic – abstract).

As per **claims 15 and 25-27**, Tobish teaches a method of modifying a telephone to enable an operator of said telephone to dial "911" by touch (C1, L28-31), said method comprising:

Providing a phone having a keypad comprising at least ten number keys arranged to dial the digits from 0-to-9 inclusive, each of said number keys being marked with a visual indicator denoting the digit which the number key is arranged to dial (figures 1 and 5 show phones with numbers 0-9 and visual indicators representing numbers 0-9 for each key);

Providing a first auxiliary member comprising a first tactile indicator (figures 1 and 5 show the "1" key with tactile indicator #18/#42);

Providing a second auxiliary member comprising a second tactile indicator distinguishable by touch from the first tactile indicator (figures 1 and 5 show "9" key with tactile indicator #18 again or #44);

Said first and second tactile indicators not being the Braille equivalents of the digits "1" and "9" ("locator aids" are not Braille equivalents);

Attaching the first auxiliary member to the number key arranged to dial the digit "1" such that the first tactile indicator does not substantially obscure the visual indicator on said number key ("locator aids" shown in figures 1 and 5 do not obscure the key, but rather mark the key's location); and

Attaching the second auxiliary member to the number key arranged to dial the digit "9" such that the second tactile indicator does not substantially obscure the visual indicator on said number key ("locator aids" shown in figures 1 and 5 do not obscure the key, but rather mark the key's location). The examiner also refers to figure 8, abstract and C2, L30 to C3, L47 and C4, L24-32 teaches non-obscuring).

As per **claim 20**, Tobish teaches a telephone keypad tactile add-ons for modifying a phone to enable an operator of said phone to dial "911" (C1, L28-31) by touch where the phone has a keypad comprising at least ten keys arranged to dial the digits from 0-to-9 inclusive (figures 1 and 5 show phones with numbers 0-9), each of said number keys marked with a visual indicator denoting the digit which the number key is arranged to dial (figures 1 and 5 show visual indicators representing numbers 0-9 for each key), said add-ons comprising:

A first auxiliary member comprising a first tactile indicator (figures 1 and 5 show the "1" key with tactile indicator #18/#42);

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A second auxiliary member comprising a second tactile indicator distinguishable by touch from the first tactile indicator (figures 1 and 5 show "9" key with tactile indicator #18 again or #44);

Said first and second tactile indicators not being the Braille equivalents of digits "1" and "9" (Tobish's "locator aids" are not Braille equivalents);

Said first and second auxiliary members being adapted to be attached to the number key arranged to dial the digit "1" such that the first tactile indicator does not substantially obscure the visual indicator on said number key and said second auxiliary member to the number key arranged to dial the digit 9 such that the second indicator does not substantially obscure the visual indicator on said number key ("locator aids" shown in figures 1 and 5 do not obscure the key, but rather mark the key's location). The examiner also refers to figure 8, abstract and C2, L30 to C3, L47 and C4, L24-32 teaches non-obscuring).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 18-19 and 23-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Tobish as applied to claims 1, 15 or 20 above, and further in view of Shindo US 5,898,774 (hereafter Shindo).

As per **claim 2**, Tobish teaches claim 1 **but is silent on** the phone has an ON key which must be pressed before said number keys can dial their associated digits, said ON key bearing a third tactile indicator distinguishable by touch from both said first and second tactile indicators.

The examiner notes that cellular/wireless phones inherently have Power/ON keys which turn on/off the phone when being used and/or to conserve battery power. The examiner also notes that the ability to use the phone in an emergency situation is of the utmost importance and one skilled would properly mark the ON key so that it can be found/located if the user cannot actually see the phone (eg. if smoke is present, is dark out, etc.).

Shindo teaches a portable/cellular phone that has a Power/ON key (figure 2a, #10 and C1, L32-35).

Addressing the third tactile indicator for the ON key, Tobish states his invention serves to provide means to locate significant keys/holes on a dialer keypad (C1, L5-10)

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and that multiple locators can be used for virtually any/all key(s) (C1, L63-65), so one skilled would use a locator for the ON key for said cell phone.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Tobish, such that phone has an ON key with a third tactile indicator, to provide means for the user to easily find the ON key during an emergency.

As per **claim 3**, Tobish in view of Shindo teaches claim 2 **but is silent on** having in addition to said ten number keys and said ON key, a SEND key which must be depressed after pressing said number keys in order to transmit the digits dialed by said number keys, said SEND key bearing a fourth tactile indicator distinguishable by touch from all of said first, second and third tactile indicators.

Shindo teaches a cell phone with SEND and END keys (figure 6, #39 and #40) which are inherently used to signal the network that a call is being/ending.

Addressing the fourth tactile indicator for the SEND key, Tobish states his invention serves to provide means to locate significant keys/holes on a dialer keypad (C1, L5-10) and that multiple locators can be used for virtually any/all key(s) (C1, L63-65), so one skilled would use a locator for the SEND key on said cell phone.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Tobish in view of Shindo, such that a SEND key is used with a fourth tactile indicator, to provide means for a user to easily find the SEND key during an emergency.

As per **claim 18**, Tobish teaches claim 15 **but is silent on** wherein said phone has an ON key which must be pressed before said number keys can dial their associated digits wherein said method comprises a third auxiliary member comprising a third tactile indicator distinguishable by touch from both said first and second tactile indicators and attaching said third auxiliary member to said ON key.

The examiner notes that cellular/wireless phones inherently have Power/ON keys which turn on/off the phone when being used and/or to conserve battery power. The examiner also notes that the ability to use the phone in an emergency situation is of the utmost importance and one skilled would properly mark the ON key so that it can be found/located if the user cannot actually see the phone (eg. if smoke is present, is dark out, etc.).

Shindo teaches a portable/cellular phone that has a Power/ON key (figure 2a, #10 and C1, L32-35).

Addressing the third tactile indicator for the ON key, Tobish states his invention serves to provide means to locate significant keys/holes on a dialer keypad (C1, L5-10) and that multiple locators can be used for virtually any/all key(s) (C1, L63-65), so one skilled would use a locator for the ON key for said cell phone.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Tobish, such that said phone has an ON key which must be pressed before said number keys can dial their associated digits wherein said method comprises a third auxiliary member comprising a third tactile indicator

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distinguishable by touch from both said first and second tactile indicators and attaching said third auxiliary member to said ON key, to provide means for the user to locate the ON key during an emergency.

As per **claim 23**, Tobish teaches claim 20 **but is silent on** wherein said phone has an ON key which must be pressed before said number keys can dial their associated digits wherein said method comprises a third auxiliary member comprising a third tactile indicator distinguishable by touch from both said first and second tactile indicators and attaching said third auxiliary member to said ON key.

The examiner notes that cellular/wireless phones inherently have Power/ON keys which turn on/off the phone when being used and/or to conserve battery power. The examiner also notes that the ability to use the phone in an emergency situation is of the utmost importance and one skilled would properly mark the ON key so that it can be found/located if the user cannot actually see the phone (eg. if smoke is present, is dark out, etc.).

Shindo teaches a portable/cellular phone that has a Power/ON key (figure 2a, #10 and C1, L32-35).

Addressing the third tactile indicator for the ON key, Tobish states his invention serves to provide means to locate significant keys/holes on a dialer keypad (C1, L5-10) and that multiple locators can be used for virtually any/all key(s) (C1, L63-65), so one skilled would use a locator for the ON key for said cell phone.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Tobish, such that said phone has an ON key which must be pressed before said number keys can dial their associated digits wherein said method comprises a third auxiliary member comprising a third tactile indicator distinguishable by touch from both said first and second tactile indicators and attaching said third auxiliary member to said ON key, to provide means for the user to locate the ON key during an emergency.

Claims 10-11, 16-17, 21-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Tobish as applied to claims 1, 15 or 20 above, and further in view of Bianchini US 4,119,809 (hereafter Bianchini).

As per **claim 10**, Tobish teaches claim 9 **but is silent on** said at least one of said tactile indicators comprises a substantially transparent plate overlying at least part of the visual indicator on its associated number key, and a substantially projection extending outwardly from said plate.

Bianchini teaches a domed member (abstract, figures 1-6) that is attached/positioned onto a keypad that provides either Braille or raised Arabic numerals (C1, L5-16) to assist a user find the correct key to push/select.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Tobish, such that at least one of said tactile indicators comprises a substantially transparent plate overlying at least part of the visual indicator

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on its associated number key, and a substantially projection extending outwardly from said plate, to provide means for the user to feel and identify each key's marker and select the key they require.

As per **claim 11**, Tobish in view of Bianchini teaches claim 10 wherein said transparent plate is secured to its associated number key with an adhesive (C3, L48-57 teaches adhesives).

As per **claim 16**, Tobish teaches claim 15 **but is silent on** wherein at least one of said first and second auxiliary members comprises in addition to the tactile indicator, a substantially transparent plate, and wherein said transparent plate is attached to said number key, leaving said tactile indicator projecting from said number key.

Bianchini teaches a domed member that is placed over key/keys and provides Braille or Arabic number markets to a person (abstract, figures 1-6 and C1, L4-16).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Tobish, such that at least one of said first and second auxiliary members comprises in addition to the tactile indicator, a substantially transparent plate, and wherein said transparent plate is attached to said number key, leaving said tactile indicator projecting from said number key, to provide means for the user to feel/identify each number key and use it during an emergency.

~~As per **claim 17**, Tobish in view of Bianchini teaches claim 16 wherein said at least one of first/second members comprises a layer of adhesive on the opposed side of said plate from said tactile indicator and wherein said auxiliary member is attached to said number key using said layer of adhesive (C3, L48-50 teaches adhesives).~~

As per **claim 21**, Tobish teaches claim 20 **but is silent on** at least one of said first/second members comprises, in addition to the indicator, a substantially transparent plate, and wherein said plate is attached to said number key, leaving said indicator projecting from said number key.

Bianchini teaches a domed member (abstract, figures 1-6) that is attached/positioned onto a keypad that provides either Braille or raised Arabic numerals (C1, L5-16) to assist a user find the correct key to push/select.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Tobish, such that at least one of said first/second members comprises, in addition to the indicator, a substantially transparent plate, and wherein said plate is attached to said number key, leaving said indicator projecting from said number key, to provide means for the user to feel/locate each key and use it during normal/emergency operations.

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Claims 12 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Tobish as applied to claims 1, 15 or 20 above, in view of Shindo US 5,898,774 and further in view of Bianchini.

As per **claim 12**, Tobish in view of Shindo teaches claim 3 **but is silent on** wherein at least one of said tactile indicators comprises an elongated ridge projecting from its associated number key.

Bianchini teaches a domed member (abstract, figures 1-6) that have an elongated ridge projecting from the number key dome (figure 2 shows raised Braille or Arabic numbers that will project from the key).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Tobish in view of Shindo, such that at least one of said tactile indicators comprises an elongated ridge projecting from its associated number key, to provide means for a marker to have a ridge that extends/projects from its key so the user can feel/identify it during an emergency.

As per **claim 14**, Tobish in view of Shindo teaches claim 2 **but is silent on** wherein at least one of said tactile indicators is substantially cruciform.

Bianchini teaches Braille or Arabic markers. One skilled would also provide for "symbols" such as the pound sign, asterisk, cruciform, etc..

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Tobish in view of Shindo, such that at least one of said tactile indicators is substantially cruciform, to provide means for the markers to be fabricated into any shape desired (eg. Braille, Arabic, symbols, etc.).

Allowable Subject Matter

Claims 4-8 allowed.

Claims 17, 19, 22 and 24 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. These claims recite highly specific designs which are not found in the prior art of record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta
PRIMARY EXAMINER
3-18-05

